

REMARKS

Claims 1-9 and 12-19 were pending in this Application. Claims 1-9 and 12-19 were rejected. Claims 2-4, 12-14, 16, and 19 have been amended in this response. Claims 1 and 6 have been cancelled without prejudice or disclaimer in this response and Claim 20 has been added. Claims 2-5, 7-9, and 12-19 remain pending. Applicant respectfully requests favorable action.

Rejections under 35 U.S.C. §103(a)

The Office rejected claims 1-9 and 12-19 under Section 103(a) as being unpatentable over Herz *et al.*, U.S. Patent Application Publication No. 2001/0014868 (hereinafter, “Herz”) in view of Roth *et al.*, U.S. Patent No. 6,285,987 (hereinafter, “Roth”) and Friedman *et al.*, U.S. Patent Application Publication No. 2003/0110293 (hereinafter, “Friedman”).

Claim 1. The Section 103(a) rejection of independent claim 1 is moot in view of the cancellation, without prejudice or disclaimer, of claim 1.

Claim 2. Applicant has amended the claim as indicated to recite, in part: grouping users in the subset into user models wherein said grouping is determined, at least in part, by said Internet service type data (indicative of a bandwidth of a user’s Internet service) and selecting web content formats corresponding to the user models.

Applicant submits that claim 2 as amended is patentable over the cited references because the cited references do not teach or suggest all of the claim elements. A Section 103(a) rejection based on a rationale of combining multiple prior art references asserts that all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.¹ Under KSR, therefore, an examiner must articulate a finding that the prior art references include each element

¹ *KSR International Co. v. Teleflex Inc.*, 550 U.S. ____ at ____, 82 USPQ2d 1385 at 1395 (2007).

claimed...with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.²

In the present case, claim 2 recites elements not taught or suggested by the references either individually or collectively. Claim 2 recites, for example, the grouping of users into user models where the grouping is influenced by the Internet service type data indicative of bandwidth of a user's Internet service. The Office admits that Herz does not teach determining the user's group/model according to a type of Internet service or according to a type of browser used. *See*, Office Action, p. 3. The Office attempts to support the rejection by asserting that:

Friedman et al teaches adapted and tailored presentation of user advertising content according to several user profile parameters, including a parameter of the user's connection speed [0158, 01611]. See Office Action at p. 3.

However, whereas claim 2 as amended recites grouping users based, in part, on Internet service type data that indicates bandwidth, Friedman is expressly directed at providing individually tailored content to customers. *See, e.g.*, Friedman ¶ [0158]. "The web site 60 can tailor the Internet site based upon the geographic location or Internet connection speed of an Internet user 5."

Friedman would not, as suggested by the Office, motivate one of ordinary skill in the art to modify Herz to use Internet bandwidth information to group a set of users because Friedman advocates individualized customization based on Internet connection speed. The concepts of grouping a set of users based on data indicative of Internet bandwidth as recited in amended claim 2 is contrary to the concept of individualized content provision as described in Friedman.

The Office also cites Roth and suggests that Roth's discussion of "user-specific IP data" provided by the user's ISP "could be argued to be inherently 'indicative' of the traits of the ISP." *See*, Office Action, p. 3. lines 10-15. Recognizing that the Office ultimately elected to rely on Friedman, and not Roth, for allegedly teaching the bandwidth claim language, Applicant

² See, e.g., Manual of Patent Examination Procedure § 2143 (A).

nevertheless submits that the IP data discussed in Roth is not inherently indicative of the user's Internet service bandwidth as suggested by the Office. A user's IP address, for example, does not inherently convey the user's Internet service bandwidth, which is a function of many factors. Although some implementations may assign different classes of services to different IP addresses or IP address / port combinations, the service bandwidth is not inherent in the IP address itself. Even within IPv6 (IETF RFC 2640), which supports the use of "traffic class" bits, the use of such bits is not mandatory and is not required to indicate assumptions about bandwidth, bit rates, or the like.

Therefore, because the cited references do not teach or suggest all of the claim elements, Applicant respectfully requests the Office to reconsider and withdraw the Section 103(a) rejection of claim 2 and its dependent claims.

Claim 14. Independent claim 14 has been amended to recite, in part, a system for providing web site content to a user, comprising: ... assign the user to a group based at least in part on the Internet service type data; [and] select a web content format based at least in part on the assigned group.

Applicant asserts that claim 14 as amended is patentable over the cited references because the cited references do not teach or suggest all of the claim elements. Claim 14 recites using Internet bandwidth information to group users into a set of distinct groups. As discussed above with respect to claim 2, Friedman emphasizes individualization of content based on connection speed. Again, Friedman's teaching of tailoring content based on connection speed is contrary to the concept of grouping users according to Internet service type data. Roth, as discussed above with respect to claim 2, also fails to teach the bandwidth element as recited in claim 14. Thus, because the cited references do not teach or suggest all of the claim elements, Applicant respectfully requests the Office to reconsider and withdraw the Section 103(a) rejection of claim 14.

New claim 20

Newly added claim 20 recites, in part, a web hosting computing device for providing a web site, where the computing device is configured to identify users associated with requests for content to the web site, determine Internet service type data associated with the requests, wherein the Internet service type data associated with a specific request indicates an Internet bandwidth associated with a user associated with the specific request, and assign a specific user to a user group based, at least in part, on the Internet bandwidth.

Applicant submits that claim 20 recites subject matter that is patentable over the references cited against the previously pending claims. Claim 20 assigns specific users to user groups based, in part, on their corresponding Internet bandwidth. As discussed above, Friedman teaches away from grouping users and favors individualization of content provision based on connection speed. Further, the cited portions of Herz and Roth also fail to disclose or suggest the specific combination of elements recited in claim 20. Applicant submits, therefore, that claim 20 is allowable.

CONCLUSION

Applicant believes that this document contains a reply to every ground of objection and/or rejection raised in the Office Action. Applicant respectfully requests favorable action for the pending Claims.

Applicants have submitted the requisite fees for an extension of time with this response; however, the Commissioner is hereby authorized to charge any other fees necessary, or credit any overpayment, to the Deposit Account of Jackson Walker L.L.P., No. 10-0096.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.236.2019.

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